

# Notice of Allowability

Application No.

09/800,890

Examiner

Yogesh C. Garg

Applicant(s)

YAMANE ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Notice of Allowance mailed on 4/13/2006.
2. ☒ The allowed claim(s) is/are 1-4,8-11,13-15 and 20.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  5. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

*Y. C. Garg*  
Primary Examiner

## **DETAILED ACTION**

### ***Supplemental Notice of Allowability***

1. This is in continuation to the Notice of Allowability mailed on 4/13/2006. In order to correct some typographical errors this Supplemental Notice of Allowability is being sent to the Applicant.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/08/2005 has been entered.

### ***Response to Amendment***

3. Applicant has amended claims 1, 8-11, 13-15 and 20, and cancelled claim 7. Claim 12 was previously cancelled and claims 5-6, and 17-19 are withdrawn. Currently claims 1-4, 8-11, 13-16 and 20-21 are pending for examination.

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**EXAMINER'S AMENDMENT**

4. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with attorney Mr. Reginald Lucas on 4/10/2006.

The application has been amended as follows:

Claim 1. (currently amended) An electronic commerce method of a server for performing a commerce with a client by using a network, comprising:

~~an order receiving step which separates~~ separating a sales article into information and goods and ~~presents~~ presenting them to the client in a providing form such that they can be selected;

~~an article providing step which selects~~ selecting the separated information, the separated goods, or a combination thereof of the separated information and the separated goods on the basis of an ordering request from ~~[[said]]~~ the client ~~and provides it to said client;~~

~~providing form analyzing step which obtains~~ obtaining a use frequency and a storing time of ~~[[an]]~~ the article ~~[[as a target]]~~ to be ordered, analyzing the obtained use frequency and a storing time of the article and ~~[[sets]]~~ setting said providing form based on the analysis; and

~~wherein said order receiving presents a providing form set in said providing form analyzing as a default providing form recommended to the client.~~

displaying the set providing form as a default providing farm.

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Claim 2. (currently amended) A method according to claim 1, wherein in ~~said article providing step~~, a time difference service such that after the separated information was precedently provided, the separated goods are provided is executed.

Claim 3. (currently amended) A method according to claim 1, wherein in ~~said article providing step~~, a separation service such that the separated information and the separated goods are respectively solely provided is executed.

Claim 4. (currently amended) A method according to claim 1, wherein said sales article is a packaged music recording medium,

in said ~~order receiving step~~ separating , said packaged music recording medium is separated into recorded music piece data, a package, music, and the recording medium itself and presented, and

in said ~~article providing step~~ selecting, the packaged music recording medium, the music piece data, a medium casing, the music, the recording medium, or a combination thereof is selected and provided to said client.

Claim 5. (Canceled).

Claim 6. (Canceled).

Claim 7. (Canceled).

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Claim 8. (currently amended) A method according to claim 1, wherein in said ~~providing form~~ analyzing step obtaining, when the use frequency of the article is low and the storing time is short, a providing form of only the information is set.

Claim 9. (currently amended) A method according to claim 1, wherein in said ~~providing form~~ analyzing step obtaining, when the use frequency of the article is high and the storing time is long, a providing form of the goods themselves is set.

Claim 10. (currently amended) A method according to claim 1, wherein in said ~~providing form~~ analyzing step obtaining, when the use frequency of the article is high and the storing time is short, a providing form of a combination of the information and the goods is set.

Claim 11. (currently amended) A method according to claim 1, wherein in said ~~providing form~~ analyzing Step obtaining, when the storing time is long although the use frequency of the article is low, a providing form of a combination of the information and the goods or a providing form of the goods themselves is set.

Claim 12. (Canceled).

Claim 13. (currently amended) A method according to claim 1, wherein in said ~~providing form~~ analyzing step obtaining, the use frequency and the storing time for the article ordered by said client are obtained with reference to a database of user information in which use environments, tastes, and the like have previously been registered.

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Claim 14. (currently amended) A method according to claim 1, wherein in said ~~providing form~~ analyzing step obtaining, the use frequency and the storing time for the article ordered by said client are obtained with reference to a database in which a use frequency and a storing time have previously been registered in correspondence to an attribute of the sales article.

Claim 15. (currently amended) A recording medium in which an electronic commerce program which is executed by a computer constructing a server for performing electronic commerce with a client by using a network has been recorded, wherein said program comprises:

~~an order receiving step which separates~~ separating a sales article into information and goods and ~~presents~~ presenting them to the client in a providing form such that they can be selected;

~~an article providing step which selects~~ selecting the separated information, the separated goods, or a combination thereof of the separated information and the separated goods on the basis of an ordering request from ~~[[said]] the client and provides it to said client;~~

~~providing form analyzing step which obtains~~ obtaining a use frequency and a storing time of ~~[[an]] the~~ article ~~[[as a target]] to be ordered,~~ analyzing the obtained use frequency and a storing time of the article and ~~[[sets]] setting~~ said providing form based on the analysis; and

~~wherein said order receiving presents a providing form set in said providing form analyzing as a default providing form recommended to the client.~~

displaying the set providing form as a default providing farm.

Claim 16. (Canceled).

Claim 17. (Canceled).

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Claim 18. (Canceled).

Claim 19. (Canceled).

Claim 20. (currently amended) A server for performing electronic commerce with a client by using a network, comprising:

an order receiving unit which separates a sales article into information and goods and presents them to the client in a providing form such that they can be selected; ~~[[ and]]~~

an article providing unit ~~which selects~~ selecting the separated information, the separated goods, or a combination thereof of the separated information and the separated goods on the basis of an ordering request from ~~[[said]]~~ the client ~~and provides it to said client;~~

a providing form analyzing unit ~~which obtains~~ obtaining a use frequency and a storing time of ~~[[an]]~~ the article ~~[[as a target]]~~ to be ordered, analyzing the obtained use frequency and a storing time of the article and ~~[[sets]]~~ setting said providing form based on the analysis; and

~~wherein said order receiving presents a providing form set in said providing form analyzing as a default providing form recommended to the client~~

displaying the set providing form as a default providing farm.

Claim 21. (Canceled).

#### ***Allowable Subject Matter***

4. Claims 1-4,8-11,13-15 and 20 are allowed. Claims 1, 15 and 20 are independent. Claims 2-4, 8-11, and 13-14 are dependencies of claim 1.

***Reasons for Allowance***

5 The following is an examiner's statement of reasons for allowance:

***Claims 1-4,8-11,13-15 &20***

The prior art of record neither anticipates nor renders obvious a method, a computer program and a system for performing electronic commerce using a network and client server architecture comprising, inter alia, the functionality of separating a sales article into information and goods, presenting them to the client in a providing form such that they can be selected, selecting the separated information, the separated goods, or a combination thereof of the separated information and the separated goods on the basis of an ordering request from the client, obtaining a use frequency and a storing time of the article to be ordered, analyzing the obtained use frequency and a storing time of the article and setting said providing form based on the analysis, and displaying the set providing form as a default providing farm(see independent claims 1, 15 and 20).

Applicant's remarks in the amendment filed on 5/25/2005 (see Remarks, page 2) are compelling and commensurate with the original disclosure that is, " For example, claims 7-11 emphasize different types of forms for the user. The prior art does not teach or suggest such. It is submitted that the dependent claims are independently patentable over the prior art ", (Note: Originally filed claim 7 recited the functionality of obtaining a use frequency and a storing time of the article to be ordered, analyzing the



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obtained use frequency and a storing time of the article and setting said providing form based on the analysis, and displaying the set providing form as a default providing form, which has now been added to all the independent claims 1, 15 and 20).

As indicated in the Final Office action mailed on 9/8/2005 (see page 3, paragraph 3, **NOTE** ) and not contested by the applicant in his subsequent responses, the process steps in claim are performed by the computerized server connected to the client's web browser using an electronic network as disclosed in the applicant's disclosure.

6. Discussion of most relevant prior art:

The following references have been identified as most relevant prior art to the claimed invention(s).

The most closely applicable prior art of record is referred to Hughes et al. (US Publication 2002/0023015 A1), hereinafter, referred to Hughes and Dockes et al. (US Patent 6,011,758), hereinafter, referred to as Dockes cited in the Final Office action mailed on 9/8/2005.

Hughes teaches an electronic commerce method of a server for performing a commerce with a client by using a network (see Figs. 1 thru 3 which disclose a client-server architecture for conducting electronic commerce using a network [Internet 10] , comprising an order receiving step which separates a sales article comprising information and a plurality of goods into information and goods and presents them to the

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client in a form such that they can be selected; and an article providing step which selects the separated information, the separated goods, or a combination thereof on the basis of an ordering request from said client and provides it to said client (see at least paragraphs 0005, 0020-0049 on pages 1 and 2-6 which disclose the Hughes discloses presenting both downloadable digital data, such as songs [see at least Figs. 6A and 6B] as well as physical storage media, such as CD or Cassettes [see at least Figs. 6c and 6d]. The downloadable data corresponds to "separated information" and physical storage media complete with contents, such as CD or Cassette tapes recorded with contents corresponds to "separated goods" as claimed in the instant application. See also all the Figures of Hughes which illustrate the Hughes invention and reads on the limitations of claim 1 of the instant application).

Dockes discloses producing customized CD, discloses a medium casing to be provided with the ordered recording medium (see at least abstract, col. 3, lines 36-40, where the jacket corresponds to the medium casing).

However, Rickard et al. and Dockes et al. alone or in combination fails to render obvious the application's above-mentioned underlined unique features(s)

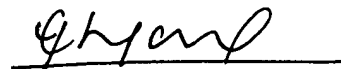
7. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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Primary Examiner  
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5/23/06